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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,955	09/24/2003	Julius Fakinlede	0106-PA-CIP	4785

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EXAMINER
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ANTHONY, JOSEPH DAVID

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 05/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/669,955

Applicant(s)

FAKINLEDE ET AL.

Examiner

Joseph D. Anthony

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) 25-52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-24, drawn to a liquid microemulsion and process of making thereof, classified in class 252, subclass 182.28.
  - II. Claims 25-39, and 43052, drawn to a halogen containing polymer and process of making thereof, classified in class 524, subclass 395.
  - III. Claims 40-42, drawn to a food grade article of manufacture, classified in class 428, subclass 1+.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as mutually exclusive inventions in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product, and the inventions are patentably distinct. In the instant case, the intermediate product is deemed to be useful as a stabilizer in non-halogenated polymers and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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3. Inventions II and III are related as mutually exclusive inventions in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product and the inventions are patentably distinct. In the instant case, the intermediate product is deemed to be useful to make non-food grade articles and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

4. Inventions I and III are related as mutually exclusive inventions in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product and the inventions are patentably distinct. In the instant case, the intermediate product is deemed to be useful as a stabilizer for non-halogenated polymers and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions

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anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

7. During a telephone conversation with Michael P. Dilworth on 05/07/04 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-24. Affirmation of this election must be made by applicant in replying to this Office action. Claims 25-52 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### ***Oath/Declaration***

9. A new oath or declaration is required because while the "UTILITY PATENT APPLICATION TRANSMITTAL" Form has the box checked that the present application

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is a CIP of prior application S.N. 10/191,440, the Declaration filed with the present application does not claim benefit to said prior application. If applicant wants to claim such benefit then a new Declaration needs to be filed. The wording of an oath or declaration cannot be amended. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

***Claim Rejections - 35 USC § 112***

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 5 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There is no antecedent basis in the claims from which these claims depend for the phrase, "basic metal compound".

13. Note: Applicant's components b) and c) as set forth in independent claims 1 and 13 overlap each other in scope. As an example, glycerin is a compound that reads on both component b) and c). This fact does not render the claims indefinite, but is nevertheless being noted.

***Claim Objections***

14. Claims 3-4 and 15-16 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The organic material of these claims is not further limiting when it is chosen to be ethoxylated alcohols when component c) in independent claims 1 and 13 is selected to be alcohol ethoxylates.

***Claim Rejections - 35 USC § 102***

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

16. Claims 1-3, 5-7, 13-15, 17-19, and 22-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Reddy et al. U.S. Patent Number 6,689,893.

Reddy et al teach microemulsion shelf stable haze free liquids of overbased alkaline earth metal carbonate/carboxylate salts, a liquid hydrocarbon, and an aliphatic alcohol having at least 8 carbon atoms. Reddy et al discloses that preferably polyhydric alcohol, such as glycol or glycol ethers (e.g. diethylene glycol, triethylene glycol etc.) are used in the microemulsions, see column 4,

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lines 1-64. The overbased compositions are made from reacting alkaline earth metal oxide and/or hydroxides with an aliphatic acid in the presence of aliphatic alcohol, carbon dioxide, a hydrocarbon solvent, and optional adjuvant such as polyhydric alcohols. The disclosed microemulsions can additionally contain other known stabilizers such as zinc soaps, e.g. zinc octoate, in combination with the alkaline earth metal carbonate/carboxylate salts, see column 8, lines 36-55.

Applicant's claims are deemed to be anticipated over the examples. Note that Tables II-V teach mix stabilizers of calcium oleate and zinc octoate.

### ***Claim Rejections - 35 USC § 103***

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 4, 8-12, 16, 20-21 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reddy et al. U.S. Patent Number 6,689,893 in view of either Sugahara et al. U.S. Patent Number 4,060,508 (for all said claims) or Werle et al. U.S. Patent Number 4,501,840 (for all said claims except 4 and 16).

Reddy et al has been described above and differs from applicant's claimed invention in the following ways: 1) there is no direct disclosure to add an organic material that is selected from ethoxylated alcohols to the overbased



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microemulsions, and, 2) there is no direct disclosure to applicant's claimed invention wherein glycerin and sorbitol are used either individually or together as co-stabilizers with the taught alkaline earth metal carbonate/carboxylate salt stabilizer containing microemulsions.

Sugahara et al discloses stabilizer compositions for chlorine-containing polymers. The patent directly discloses polyhydric alcohols, such as glycerin, sorbitol, alkylene glycols, and ethylene oxide or propylene oxide adducts of polyhydric alcohols, as known stabilizers for chlorine-containing polymers, see column 12, lines 5-21.

Sugahara et al also discloses mixtures of stabilizer and discloses metal soaps, such as calcium and/or zinc soaps as stabilizers for halogen-containing polymers, see column 13, lines 6-14 and 44-49.

Werle et al discloses alkaline polyhydric alcohols as co-stabilizers with metal carboxylate salt stabilizers, such as calcium and/or zinc stearate, for vinyl chloride resins.

It would have been obvious to one having ordinary skill in the art to use the direct disclosure of Sugahara et al to ethylene oxide or propylene oxide adducts of polyhydric alcohols, as known stabilizers for chlorine-containing polymers, as strong motivation to actually use such adducts as co-stabilizers in the overbased microemulsions taught by Reddy et al..

It would also have been obvious to one having ordinary skill in the art to use the direct disclosure to glycerin and/or sorbitol as effective stabilizers for chlorine-containing polymers as strong motivation to actually use them as co-stabilizers in the overbased

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microemulsions taught by Reddy et al.. Please note that both Sugahara et al and Werle et al also disclose the use of metal carboxylates as stabilizers for chlorine-containing polymers. As such, these secondary references provide strong motivation to use glycerin and sorbitol as effective co-stabilizers with overbased metal carboxylate stabilizers.

19. Claims 4 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reddy et al. U.S. Patent Number 6,689,893 in view of either Benda et al. U.S. patent Number 5,501,807 or Dworkin et al. U.S. Patent Number 4,085,077.

Reddy et al has been described above and differs from applicant's claimed invention in that there is no direct disclosure to add an organic material that is a substituted or unsubstituted aromatic hydrocarbon.

Benda et al teaches overbased metal carboxylate compositions that use aromatic compounds, such as toluene, benzene and naptha as solvents, see example 1 and claim 3.

Dworkin et al teaches method for stabilizing vinyl chlorine polymers using overbased compositions that comprise metal carboxylates in combination with other ingredients, one of which is a solvent, such as naptha, benzene, toluene, mineral oil etc., see column 2, lines 25-43 and the examples.

It would have been obvious to one having ordinary skill in the art to use the direct disclosure of the secondary references to Benda et al or Dworkin et al as strong motivation to actually use an aromatic hydrocarbon as an additional solvent in the

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overbased compositions taught by Reddy et al for the benefits that such aromatic hydrocarbon solvents provide such overbased compositions.

### ***Double Patenting***

20. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

21. Claims 1-24 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-24 of copending Application No. 10/191,440. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

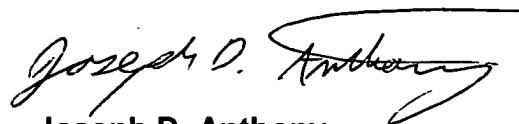
### ***Prior-Art Cited But Not Applied***

22. Any prior-art reference which is cited on FORM PTO-892 but not applied, is cited only to show the general state of the prior-art at the time of applicant's invention.

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***Examiner Information***

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Joseph D. Anthony whose telephone number is (571) 272-1117. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (571) 272-1119. The centralized FAX machine number is (703) 872-9306. All other papers received by FAX will be treated as Official communications and cannot be immediately handled by the Examiner.



**Joseph D. Anthony**  
**Primary Patent Examiner**  
**Art Unit 1714**

5/7/04